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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,648	12/10/2001	Noriyoshi Shida	Q67621	2208

7590 12/12/2005
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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EXAMINER

JOLLEY, KIRSTEN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,648

Applicant(s)

SHIDA ET AL.

Examiner

Kirsten C. Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 15, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 15, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's submission of certified English translations of the foreign priority documents are sufficient to overcome the 35 USC 102 and 103 rejections over Decre. Therefore, the rejections have been withdrawn.

However, upon further consideration, rejections over the prior art of Plows et al. are re-applied, and new rejections are made over the prior art of Kikuchi, and thus this action is made non-final.

2. The 35 USC 112 and 102 rejections of claim 26 have been withdrawn in response to the cancellation of claim 26.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-5, 15, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plows et al. (US 4,075,974).

Plows et al. discloses a film forming apparatus comprising a rotating unit (spindle 7) for rotating a substrate (disk 15), and a film forming jig (distributor 31) which is placed on the disk substrate, whereby film forming liquid is supplied to an outer periphery of the film forming jig

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and the rotation unit is rotated to form a film (col. 3, lines 21-32 and 50-66). When the substrate and jig are rotated together with film forming liquid thereon, the film forming liquid will spread over the surface and down the side of the jig. Applicant's specification teaches that the outer peripheral face of a conical jig is the downwardly-sloped surface 22b (as illustrated in Figures 7 and 8B and discussed on page 17).

Plows et al. lacks a teaching that the supply pipe is positioned eccentrically from an axial center of the film forming jig so as to be positioned adjacent to the outer peripheral surface of the film forming jig. However, it is noted that the film forming jig/distributor 31 of Plows et al. has a slot 32 in the apex of the cone for receiving a screw driver blade (to screw the jig into place). It is the Examiner's position that it would have been obvious to one having ordinary skill in the art to have positioned the supply pipe/syringe just slightly eccentric of the apex of the conical jig in Plows et al.'s apparatus in order to avoid filling the screw driver slot 32 with coating material, which would then need to be subsequently cleaned before its removal. Further, since the substrate is rotated while the film forming liquid is applied, film forming liquid would be uniformly applied to the jig and substrate, regardless of whether the supply pipe is positioned at the axial center or slightly eccentric from the axial center. Therefore, similar and successful results would be expected.

It is noted that film forming liquid in Plows et al.'s apparatus supplied at a position eccentric from the axial center would be supplied directly to the downwardly-sloped surface of the conical jig, or the jig's outer peripheral face.

As to claim 2, the substantially conical jig/distributor 31 illustrated in Figure 1 has a thickness larger than that of the film formed.

As to claim 5, Plows et al. also teaches use of a substantially truncated conical shape as illustrated in Figure 2. Similarly, it is the Examiner's position that it would have been obvious to one having ordinary skill in the art to have positioned the supply pipe/syringe just slightly eccentric of the apex of the truncated conical jig in Plows et al.'s apparatus in order to avoid filling the screw driver slot 32 with coating material, which would then need to be subsequently cleaned before its removal.

As to claim 15, it is well settled that the intended uses of and the particular material used in a coating apparatus have no significance in determining patentability of apparatus claims. *Ex parte Thibault*, 164 USPQ 666 (Bd. Pat. App. 1969).

As to claims 23 and 24, the outer peripheral face of Plows et al.'s conical or truncated conical jig is a peripheral side surface of the jig, and the supply portion is disposed directly to the peripheral side surface.

5. Claims 1-3, 15, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi (US 5,980,985).

Kikuchi discloses a prior art embodiment of a film forming apparatus comprising: a rotating unit, and a supply pipe for supplying a film forming liquid positioned eccentrically from an axial center of the substrate (see Figure 1). Kikuchi lacks a teaching of using a film forming jig in this embodiment of Figure 1, however illustrates use of a cylindrical film forming jig in its embodiment of Figure 6. It would have been obvious to one having ordinary skill in the art, utilizing the prior art apparatus of Figure 1, to have added a film forming jig to the apparatus in order to protect the inner edge of the substrate from being unintentionally coated with liquid

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since a coating is not desired in that area. It is the Examiner's position that use of a film forming jig to protect the inner edge of the substrate would necessarily result in supplying film forming liquid directly to the outer peripheral face of the film forming jig because any area where a coating is not desired is covered by the jig, leaving the application of coating material directly abutting the peripheral edge of the jig.

As to claim 2, Kikuchi illustrates in Figure 6 that the film forming jig's thickness is larger than that of the film. As to claim 15, Kikuchi also teaches use of its apparatus with an optical disc substrate.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Wednesday.

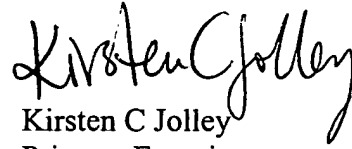
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, reading "Kirsten C Jolley". The signature is written in a cursive, flowing style.

Kirsten C Jolley
Primary Examiner
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kcj